



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,714	06/04/2001	Morenike Awokola	FA1002 US NA	4978

23906 7590 01/05/2006

E I DU PONT DE NEMOURS AND COMPANY  
LEGAL PATENT RECORDS CENTER  
BARLEY MILL PLAZA 25/1128  
4417 LANCASTER PIKE  
WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
----------	--------------

1762

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,714

Applicant(s)

AWOKOLA ET AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6,8,10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8,10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. Amendment filed on 11/07/2005 has been entered. Claims 1-3, 6, 8, 10, and 13 are pending in the application.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Rejection of claim 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6, 10, 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maag et al (DE-A-197 57 082 or WO 99/26733) in view of Richard (US 5,091,211) for the reasons of record set forth in paragraph 7 of the Office Action mailed on 6/22/2005.
6. Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Maag et al in view of Richard, further in view of Brehm et al (US 5,700,576) for the reasons of record set forth in paragraph 8 of the Office Action mailed on 6/22/2005.

***Declaration***

7. The Declaration under 37 CFR 1.132 filed 11/07/2005 is insufficient to overcome the rejection of claims 1-3, 6, 8, 10, and 13 based upon prior art of record as set forth in the last Office action because the Declaration allegedly compared coating composition of claimed invention comprising isobornyl methacrylate of claim 8 as a component B with a coating composition of Maag et al in view of Richard comprising 2-hydroxy ethyl methacrylate and of methyl methacrylate as a component B.

However, two errors occurred in the Declaration: (i) claim 1 recites broadly ester of methacrylic acid with ***any*** cycloaliphatic alcohol not necessarily isobornyl methacrylate of claim 8; (ii) a component B of Maag et al in view of Richard is “ester of methacrylic acid of ***any*** cycloaliphatic alcohol” NOT 2-hydroxy ethyl methacrylate or methyl methacrylate used in the comparative experiments of the Declaration.

As to a component B of Maag et al in view of Richard, Maag teaches that a surfacer (filler) coating composition for automotive repair lacquering comprises a **mixture** of binders (See column 3, line 12), e.g. a mixture of polyurethane methacrylate prepolymer (claimed component A) (See column 3, lines 1-12) and a prepolymer having molecular mass of **200** and having on average **2** olefinic double bonds per molecule, **preferably cycloaliphatic** (meth)acrylates (i.e. **esters of methacrylic acid** of cycloaliphatic alcohols) (See column 3, lines 8-9). Maag further teaches that the prepolymers may be used in combination with 1-50 % of reactive diluents, that is to say reactive polymerizable liquid monomers (See column 3, lines 13-16) such as **esters of methacrylic acid** (See column 3, line 20). Since *cycloaliphatic* (meth)acrylate prepolymer having molecular mass as low as 200 is reactive polymerizable **liquid**

Art Unit: 1762

ester of methacrylic acid it is clearly may be used as a **reactive ester of methacrylic acid diluent** (claimed component B) with polyurethane methacrylate prepolymer (claimed component A).

***Response to Arguments***

8. Applicants' arguments filed 11/07/2005 have been fully considered but they are not persuasive.

(A) Applicants state that the Declaration filed 11/07/2005 overcomes the rejection over Maag et al in view of Richard.

The Examiner respectfully disagrees with this argument for the reasons discussed in the paragraph 7.

(B) Applicants state that there is no motivation or suggestion to combine Brehm et al. with Maag et al. and Richard. Brehm et al. is directed to scratch-resistant coatings for plastic articles. Indeed, the word "metal" is mentioned once in the entire disclosure of Brehm et al., and only to note that "there is no expectation that thermoplastically deformable plastics will achieve the scratch-resistance of most metals or mineral glasses" (column 1, lines 16-18). On the other hand, the claimed invention is directed the application of a filler coating composition to a metal substrate (see step a of claim 1).

The Examiner respectfully disagrees with this argument. Brehm et al is a secondary reference which is relied upon to show that monofunctional reactive thinners, such as isobornyl methacrylate (See column 5, line 59) may be used in combination with acrylic prepolymers (See column 4, lines 5-13) in a radiation curable coating composition (See column 7, lines 14-25) for

Art Unit: 1762

coating automobile parts (See column 6, lines 33-35, 42) to provide **good flow properties of the coating composition and thereby good processibility** (See column 5, lines 50-53).

Thus, plastics or metal substrate are irrelevant. One of ordinary skill in the art would have reasonable expectation of success of using teaching of Brehm et al in Maag et al. and Richard to provide *good flow properties of the coating composition and thereby good processibility* because Maag et al. and Richard **do not limit** their reactive diluents to **specific cycloaliphatic methacrylates**.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

Art Unit: 1762

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-142323. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy  
Primary Examiner  
Art Unit 1762

ELENA TSOY  
PRIMARY EXAMINER  
*ETsoy*

December 28, 2005